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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/045,618	10/23/2001	William T. Evans	385/9-1487US	1047

7590 01/22/2004

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EXAMINER

BOSWELL, CHRISTOPHER J

ART UNIT	PAPER NUMBER
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3676

DATE MAILED: 01/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/045,618

Applicant(s)

EVANS ET AL.

Examiner

Christopher Boswell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s). _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, and 4-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over the website www.greatclubs.com, in view of the website www.gnc.com.

Greatclubs discloses the invention substantially as claimed. Greatclubs discloses a system for automated delivery of gifts with means for a sender to select an appropriate subset of a group of gifts to be sent to a recipient as a gift (page 1), means for inputting recipient and sender data and for storing the data (pages 14-19), means for assembling and packaging the gift in a gift package (page 5, paragraph 6), means for generating a gift letter using the sender and recipient data for sending the gift package to the recipient (page 5, paragraph 4). A gift card is considered to be an equivalent of a gift letter since the two perform substantially the same function in substantially the same way to produce substantially the same result (both are packaged in an envelope, sent via post, and both inform the recipient of the feelings of the sender and convey the fact that a gift is being sent). However, Greatclubs does not disclose the group of products being health care products. GNC teaches of ordering and sending of a group of products which are health care products, including that of weight management, general nutritional support, anti-aging, vitamins and minerals in the analogous art of a system of ordering products for the purpose of contributing to the good health of others. Applicant's listing of products in the

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independent claims is considered to be a "Markus Group", and as such, only one of the products need be found to meet the claim. It would have been obvious to one with ordinary skill in the art at the time the invention was made to offer vitamins as a gift from the system and method disclosed by Greatclubs in order to contribute to the general health of friends and family, wherein the type of gift being offered is an intended use of the automation system, and thus does not change the structural limitation of the claimed system.

Greatclubs.com also discloses the means for generating an acknowledgment using the supplied data and incorporating the acknowledgement in the gift package (page 5, paragraph 4), as in claims 2 and 5, that the gift can be shipped every month for a given period of time, depending on the schedule that the sender or recipient establish (page 5, paragraph 2), as in claims 6-8, and 10-12, as well as comprising means for assembling and packaging the gift in a gift package (page 5, paragraph 6), as in claims 4 and 9.

Response to Arguments

Applicant's arguments with respect to claims 1-2, and 4-5 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following documents are cited to further show the state of the art with respect to systems for ordering products:

U.S. Patent Number 5,235,509 to Mueller et al., U.S. Patent Number 5,056,029 to Cannon, U.S. Patent Number 5,036,472 to Buckley et al., U.S. Patent Number 4,797,818 to Cotter, The websites www.vitamingiftbasket.com and www.vitamingifts.com.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Boswell whose telephone number is (703) 305-4067.

The examiner can normally be reached on 8:30 - 5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight can be reached on (703) 308-3179. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9326.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.



Anthony Knight
Supervisory Patent Examiner
Technology Center 3600

CJB